

### **REMARKS**

Claims 11 – 29 and 40 – 58 are pending. Claims 1 – 10, 30 – 39 and 59 – 73 are withdrawn. By this amendment, claims 13, 20, 23, 24, 28, 40, 42, 49, 52, 53, and 57 are amended and claims 11, 12, 22, and 51 are cancelled. Claims 28, 42, and 57 are amended solely to correct antecedent basis. Claims 23 and 52 are amended to correct their stated dependence based on the cancellation of claims 22 and 51, respectively. No new matter is introduced. Reconsideration and issuance of a Notice of Allowance are respectfully requested.

Applicant thanks Examiner Paula for the courtesies extended to applicant's representative during an August 10, 2005 personal interview. The substance of that interview is incorporated in the remarks that follow.

On page 3 the Office Action objects to claims 20 – 27. Claim 20 is amended. Withdrawal of the objection to claims 20 – 27 is respectfully requested.

On page 3, the Office Action rejects claims 11 – 58 under 35 U.S.C. § 112, ¶ 2 because the term “subscriber” in independent claims 11, 13, 20, 28, 40, 42, 49, and 57 lacks antecedent basis. Claims 13, 20, 28, 40, 42, 49, and 57 are amended. Claim 11 is cancelled. Claims 30 – 39 are withdrawn. Withdrawal of the rejection of claims 11 – 58 under 35 U.S.C. § 112, ¶ 2 is respectfully requested.

On page 3 the Office Action rejects claims 11 – 13, 15 – 23, and 25 – 29 under 35 U.S.C. § 103(a) over U.S. Patent 5,499,330 to Lucas et al. (hereafter Lucas) in view of U.S. Patent 5,146,552 to Cassorla (hereafter Cassorla). This rejection is respectfully traversed.

#### **CLAIMS 11 and 12**

Claims 11 and 12 are cancelled and the rejection of these claims is moot.

#### **CLAIM 13**

Considering claim 13, the Office Action asserts that “Lucas discloses the display of multiple documents on a screen or viewer. A user assigns various separation and formatting constraints – *receiving a request from the subscriber for displaying at least one page* – for defining parent-child relationships among the documents (col. 1, lines 49-col.2, line 7).” The Office Action then asserts that Lucas's teaching of document display in a U-shaped manner reads on “the document objects are displayed, and formatted simultaneously as commanded by the user.” The Office Action admits that Lucas does not disclose an electronic book, but

cites Cassorla for disclosing highlighting and annotating electronic books. The Office Action concludes that it would have been obvious to combine Lucas and Cassorla “because Lucas teaches the organization of documents in an intuitive way [and] ... [t]his would provide the benefit of allowing a user to read the electronic book in a more effective fashion using a display method that is more intuitive.”

Lucas is directed to a computerized document display system wherein electronic versions of hard copy documents may be displayed in a manner that simulates piles of hard copy documents on a desk. Lucas’s system is thus intended to make the electronic document display more intuitive in that the electronic document display mimics a physical display. Lucas’s system is capable of displaying multiple documents on a single screen. In fact, for Lucas’s system to work, the multiple electronic documents must be displayed on a single screen. That is, the electronic documents are tied by strands in either or both piles and a tiled format. “Strands are not containers, but rather are a mechanism for arranging screen objects without hiding them.” *See* col. 8, lines 45 – 46. A pile is a strand “where all the documents attached to a strand are constrained to be next to each other in the shape of a pile.” *See* col. 8, lines 51 – 53. Clearly, the documents cannot appear to be next to each other in a pile if the documents are displayed on more than one screen. Strands can be straight (see, for example, Figure 1), U-shaped, or corkscrew-shaped. A U-shaped strand makes the displayed documents “look like they’re beside each other, like pieces of paper on a table.” *See* col. 11, lines 13 – 14.

Cassorla is directed to a system for creating note, bookmarks, and annotations, and relating them to specific locations in an electronic document.

In its rejection of claim 13, the Office Action does not even address many of the features or elements recited in claim 13. For example, nowhere does the Office Action assert that Lucas or Cassorla disclose or suggest a viewer having a plurality of screens. Although this feature is recited in the claim preamble, it is repeated in the second element of the claim, namely “formatting the selected page for display on the screens of the viewer” (emphasis added), and again in the third element.

More specifically, and in contrast to Lucas and Cassorla, amended claim 13 recites “a viewer having a plurality of hardware screens.” Claim 13 has been amended to make clear that the “screens” are in fact hardware devices, such as flat panel displays. In contrast to hardware screens, windows are software constructs that can be shown on a screen and used to organize data, text, images, and other matter. The term “windows” was long ago adopted to refer to this specific software construct. For example, Newton’s Telecom Dictionary, 17<sup>th</sup> ed.

defines a window as a display of “information on a screen in which the viewer sees what appears to be several sheets of paper much as they would appear on a desktop.” A copy of this reference is attached.

Claim 13 recites a plurality of hardware screens. Possible arrangements of this plurality of screens are shown at least in Figures 26a – 26e, and are described in the accompanying text at page 52, line 12 to page 54, line 17. Thus, the structure recited in claim 13, a plurality of hardware screens, is a number of hardware-based devices, each of which can display a single page, multiple pages, or a portion or portions of a page, of an electronic book. As discussed during the personal interview, Lucas simply does not disclose or suggest this feature. Cassorla does nothing to cure this defect in Lucas. Accordingly, Lucas and Cassorla cannot serve as a basis for rejection claim 13 under 35 U.S.C. § 103(a), and claim 13 is, therefore, patentable.

#### **CLAIM 16**

The Office Action asserts that the U-shaped “pile of document objects” in Lucas reads on the claimed formatting step that includes “enlarging the page for proportional display across the screens.” Applicant respectfully disagrees. There is nothing in Lucas that discloses or suggests a page that is formatted for proportional display across screens. First, the documents shown in one of Lucas’s U-shaped piles are clearly not proportional. Second, the Lucas documents are shown on one screen, not a number of screens. Thus, Lucas does not disclose or suggest all the features of claim 16, and claim 16 is patentable. Claim 16 is also patentable because of its dependence on patentable claim 13.

#### **CLAIM 17**

Similar to claim 16, claim 17 includes the feature of proportional display across multiple screens. None of the references cited in the Office Action disclose or suggest this feature. Furthermore, the Office Action appears to be equating electronic versions of documents to screens. They are not equivalent, and one does not suggest the other. Lucas discloses electronic documents; claim 17 recites multiple screens. For these reasons, and its dependence on patentable claim 13, claim 17 is also patentable.

#### **CLAIM 18**

In its rejection of claim 18, the Office Action asserts that “the document objects are detected.” Document objects are not screens, they are electronic versions of paper documents. Claim 18 recites “detecting a number of screens within the viewer.” Accordingly, the reason stated in the Office Action for rejecting claim 18 makes no sense whatsoever. Simply put, Lucas and Cassorla, individually and in combination, do not

disclose or suggest “detecting a number of screens within the viewer.” Thus, claim 18 is patentable. Claim 18 is also patentable because of its dependence on patentable claim 13.

#### **CLAIM 19**

As with its rejection of claim 18, the Office Action, in rejecting claim 19, appears to be equating electronic versions of documents disclosed in Lucas with the screens recited in claim 19. Screens are not documents, nor are they even remotely similar. Again, Lucas and Cassorla, individually and in combination, do not disclose all the features of claim 19, and claim 19 is patentable. Claim 19 is also patentable because of its dependence on patentable claim 13.

#### **CLAIMS 20 and 22**

Claim 20 has been amended to incorporate all the features of claim 22, and claim 22 is cancelled. Considering the rejection of claims 20 and 22, and more specifically the rejection of claim 22, the Office Action asserts that “Lucas discloses the display of multiple documents, such as scanned documents – *inset image*-on a screen or viewer.” Assuming, *arguendo*, that Lucas does teach display of multiple documents on a screen or viewer, that has absolutely nothing to do with the feature recited in claim 22. As discussed during the personal interview, claim 22 (again, claim 22 is now cancelled and its features incorporated into claim 20) recites “displaying the content from the information source as an inset image within the displayed portion of the electronic book.” In other words, the content from the information source now resides within the boundaries of a displayed page of the electronic book. Lucas’s display of multiple documents does not constitute one document inset into another document. Thus, claim 20, which incorporates the features of claim 22, is now patentable.

#### **CLAIM 27**

In its rejection of claim 27, the Office Action equates Lucas’s U-shaped configuration of documents as reading on the claimed “receiving a video signal as the content from the information source.” Applicant cannot understand how the Examiner can possibly equate the two. How does a U-shaped pile of documents teach receiving a video signal? Clearly it does not, and the Examiner appears to just be stretching Lucas in an effort to find any justification (however unsupported) for rejecting claim 27. Applicant contends that nothing in Lucas discloses or suggests receiving a video signal, and that, therefore, claim 27 is patentable. In addition, claim 27 depends from patentable claim 20, and for this additional reason, claim 27 is also patentable.

## **CLAIM 28**

Again, the Office Action asserts that Lucas's U-shaped piles of documents reads on the claimed inset images. Applicant again disagrees. As discussed during the personal interview, one electronic document piled on top of another electronic document is not the same as providing an inset image that overlays a portion of another document such that the inset image is displayed "within the displayed portion of the electronic book." Furthermore, Lucas does not "format the page ... to display a portion of the page otherwise concealed by the inset image." Cassorla does nothing to cure this defect in Lucas. Because Lucas and Cassorla, individually and in combination, do not disclose or suggest these features, claim 28 is patentable.

## **CLAIMS 15, 21, 23, 25, 26, AND 29**

Claim 15 depends from patentable claim 13, claims 21, 23, 25, and 26 depend from patentable claim 20, and claim 29 depends from patentable claim 28. For these reasons and the additional features they recite, claims 15, 21, 23, 25, 26, and 29 are also patentable.

In view of the above remarks, Applicant respectfully requests withdrawal of the rejection of claims 11 – 13, 15 – 23, and 25 – 29 under 35 U.S.C. § 103(a).

On page 9 the Office Action asserts that claims 40 – 42, 44 – 52, and 54 – 58 are directed towards an apparatus for implementing the steps found in claims 11 – 13, 15 – 23, and 25 – 29, respectively, "and therefore are similarly rejected." This rejection is respectfully traversed.

## **CLAIM 40**

Claim 40 is amended to recite the viewer comprising a plurality of hardware screens and a display module that simultaneously displays the portions of the selected pages on the plurality of hardware screens of the viewer. As noted above, Lucas and Cassorla, individually and in combination, do not disclose a plurality of hardware screens. Hence, claim 40 is patentable.

## **CLAIM 42**

Claim 42 recites a plurality of hardware screens and a display module that provides the selected page for display across the screens of the viewer. As noted above, Lucas and Cassorla, individually and in combination, do not disclose a plurality of screens. Hence, claim 42 is patentable.

#### **CLAIM 49**

Claim 49 is amended to incorporate all the features of claim 51, and claim 51 is cancelled. As noted above with respect to the rejection of claim 20, claim 49 now recites features that clearly are not taught or suggested by Lucas and Cassorla, individually and in combination. Specifically, amended claim 49 now recites the display module displays the content from the information source as an inset image within the displayed portion of the electronic book. Since Lucas and Cassorla do not disclose or suggest this feature, amended claim 49 is patentable.

#### **CLAIM 57**

Claim 57 recites, among other patentable features, "a first display module that displays the content from the information source as an inset image within the page of the electronic book." As noted above with respect to the rejection of claims 20 and 49, Lucas and Cassorla, individually and in combination, do not disclose or suggest this feature. Accordingly, claim 57 is patentable.

#### **CLAIMS 41, 44 – 48, 50 – 52, 54, 55, AND 58**

Claim 51 is cancelled and hence its rejection is moot. Claim 41 depends from patentable claim 40, claims 44 – 48 depend from patentable claim 42, claims 50, 52, 54 and 55 depend from patentable claim 49, and claim 58 depends from patentable claim 57. For these reasons and the additional features they recite, claims 40, 44 – 48, 50, 52, 54, 55, and 58 are also patentable.

In view of the above remarks, Applicant respectfully requests withdrawal of the rejection of claims 40 – 42, 44 – 52, and 54 – 58 under 35 U.S.C. § 103(a).

On page 10 the Office Action rejects claims 14 and 43 under 35 U.S.C. § 103(a) over Lucas in view of Cassorla and further in view of Barnes, "10 Minute Guide to Windows 3.1" (hereafter Barnes). This rejection is respectfully traversed.

#### **CLAIM 14**

Considering claim 14, the Office Action asserts that Barnes teaches copying and pasting from one window to another window. The Office Action then asserts that this teaching, in combination with Lucas and Cassorla, renders obvious the claimed use of three screens.

As noted above with respect to the rejection of claim 13, hardware screens are not the same as windows. Furthermore, at best, Barnes discloses two windows, not three. In other words, Barnes discloses copying from a first window and pasting into a second window.

In contrast to Lucas, Cassorla, and Barnes, claim 14 recites “formatting the page for display on three screens.” This feature is not disclosed or suggested by Lucas, Cassorla, and Barnes, individually, and in combination, and hence, claim 14 is patentable. In addition, claim 14 is patentable based on its dependence on patentable claim 13.

#### **CLAIM 43**

Claim 43 recites a format module that formats the page for display across three screens. As noted above with respect to the rejection of claim 14, Lucas, Cassorla, and Barnes, individually and in combination, do not disclose or suggest this feature. Accordingly, claim 43 is patentable. In addition, claim 43 is patentable based on its dependence of patentable claim 42.

In view of the above remarks, Applicants respectfully request withdrawal of the rejection of claims 14 and 43 under 35 U.S.C. § 103(a).

On page 10 the Office Action rejects claims 24 and 53 under 35 U.S.C. § 103(a) over Lucas in view of Cassorla and further in view of U.S. Patent 5,625,833 to Levine (hereafter Levine). This rejection is respectfully traversed.

#### **CLAIM 24**

Considering claim 24, the Office Action admits that Lucas does not disclose the recited wrapping function. However, the Office Action asserts that Levine teaches automatically wrapping a word to the next line when typing using a word processing program.

Applicants agree that Levine does disclose wrapping a typed word to a next line when the typing cursor reaches a page margin. However, as discussed during the personal interview, Levine’s wrapping function has absolutely nothing to do with the wrapping function recited in claim 24. Claim 24 recites the step of displaying the portion of the electronic book as “wrapping around the displayed content from the information source.” That is, the portions of the electronic book are displayed without obscuring any of the text of the portion of the electronic book because of the wrapping feature. In Levine’s system, the word that wraps to the next line on the page does not wrap around any displayed content. Hence there is a clear distinction between what Levine discloses, and the plain meaning of the feature recited in claim 24.

Furthermore, claim 24 is amended as an independent claim that incorporates all the features of patentable claim 20. For this reason, and because Lucas, Cassorla, and Levine, individually and in combination, do not disclose or suggest all the features of claim 24, claim 24 is patentable.

### CLAIM 53

Similar to claim 24, claim 53 recites an apparatus that executes a wrapping function “herein the display module displays the portion of the electronic book as wrapping around the displayed content from the information source.” Lucas, Cassorla, and Levine, individually and in combination, do not disclose or suggest this feature. In addition, claim 53 is amended as an independent claim to incorporate all the features of independent claim 49. As noted above, claim 49 is patentable. For these reasons, claim 53 is patentable.

In view of the above remarks, Applicant respectfully requests withdrawal of the rejection of claims 24 and 53 under 35 U.S.C. § 103(a).

In view of the above remarks, Applicant respectfully submits that the application is in condition for allowance. Prompt examination and allowance are respectfully requested.

Should the Examiner believe that anything further is desired in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicant’s undersigned representative at the telephone number listed below.

Respectfully submitted,



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Attachment: Newton’s Telecom Dictionary, page 768